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Application No.: 09/944,165
Pre-Appeal Brief Request for Review

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Miika Silfverberg et al

Serial No.: 09/944,165

Filed: September 4, 2001

For: ZOOMING AND PANNING
CONTENT ON A DISPLAY SCREEN

Atty. Docket No.: 004770.00018

Group Art Unit: 2673

Examiner: Shapiro, Leonid

Confirmation No.: 9859

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Box AF

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

REMARKS

Having received and reviewed the Advisory Action dated September 9, 2005, Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

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The Advisory Action indicates that Applicants' arguments regarding a lack of motivation to combine the Nishimura reference with either the Kung or Phillipps references is not persuasive because:

Nishimura concerns with minimum object distance and listed as further object of the invention to provide zoom operation without feeling the existence of minimum object distance (See Col. 2, lines 55-60). Kung is also concerns with minimum amount of icons according with zoom signals (See Abstract). Therefore, results of zooming will look natural in Kung et al. invention. On the same page, last

However, this does not refute Applicants' argument in the Amendment dated August 26, 2005, that the zooming system of Nishimura is directed to making zooming look natural as a video camera changes from an optical zoom lens to a digital zoom, and vice versa. Neither Kung nor Phillipps teaches or suggests the need for a natural transition from an optical lens zoom to a digital zoom. Indeed, neither Kung nor Phillipps even use an optical zoom lens. Thus, there is no need for either Kung or Phillipps to transition from an optical zoom to a digital zoom, and there is thus neither a motivation to combine the references nor an expectation of success in the resultant combination of Kung and Phillipps with Nishimura. Thus the Office has not established a *prima facie* case of obviousness.

In addition, the Advisory Action's statement, to the extent Applicants understand it, does not prove the existence of a motivation to combine the references. Applicants respectfully submit that even if Nishimura "concerns with minimum object distance and listed as fuher [sic] object of the invention to provide zoom operation without feeling the existence of minimum object distance" and even if Kung "concerns with minimum amount of icons according with zoom signals," this does not provide any motivation to combine the references. The Advisory Action does not establish *why* these two conclusory statements amount to a motivation or suggestion to combine one reference with the other, and thus fails to establish a *prima facie* case of obviousness.

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In addition to the above, even assuming that the Advisory Action is correct, which Applicants maintain it is not, the Advisory Action does not address all of Applicants' arguments with respect to other claims.

For example, in the August 26, 2005, Amendment, Applicants submitted additional arguments supporting the patentability of claims 1, 3-8, 10, and 12-17, 19, 21-27, and 30 with respect to the claimed zoom-ratio versus the zoom-ratio described in Nishimura. These arguments were not contested in the Advisory Action, and the Office has failed to establish a *prima facie* case of obviousness with respect to these claims.

In the August 26, 2005, Amendment, Applicants also submitted additional arguments supporting the patentability of claims 32 and 33 with respect to written description support under 35 U.S.C. § 112. These arguments remain uncontested in the Advisory Action, and the Office has failed to establish a *prima facie* case of obviousness with respect to these claims.

In the August 26, 2005, Amendment, Applicants also submitted additional arguments supporting the patentability of claims 28-29 with respect to a lack of motivation to combine Tanaka with the other cited references. These arguments remain uncontested in the Advisory Action, and the Office has failed to establish a *prima facie* case of obviousness with respect to these claims.

In the August 26, 2005, Amendment, Applicants also submitted additional arguments supporting the patentability of claim 36 with respect to a lack of motivation to combine Sakai with the other cited references. These arguments remain uncontested in the Advisory Action, and the Office has failed to establish a *prima facie* case of obviousness with respect to this claim.

In the August 26, 2005, Amendment, Applicants also submitted additional arguments supporting the patentability of claims 31 and 34 with respect to a lack of motivation to combine Harada with the other cited references. These arguments remain uncontested in the Advisory

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Action, and the Office has failed to establish a *prima facie* case of obviousness with respect to these claims.

In the August 26, 2005, Amendment, Applicants also submitted additional arguments supporting the patentability of claim 35 with respect to a lack of motivation to combine Neff with the other cited references. These arguments remain uncontested in the Advisory Action, and the Office has failed to establish a *prima facie* case of obviousness with respect to this claim.

Finally, Applicants note that the Advisory Action does not indicate whether or not the amendments made in Applicants' previous response were entered.

CONCLUSION

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 16 day of Sept., 2005

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